UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,114	03/02/2004	Yasuhiro Urata	249501US90	1146

22850   7590   02/05/2009
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
ZENATI, AMAL S

ART UNIT	PAPER NUMBER
2614	

NOTIFICATION DATE	DELIVERY MODE
02/05/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

	Application No.	Applicant(s)
Office Action Summary	10/790,114	URATA ET AL.
	Examiner	Art Unit
	AMAL ZENATI	2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 October 2008_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-7_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-7_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set

forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent art.
    4.   Considering objective evidence present in the application indicating obviousness or
           nonobviousness.

2.   Consider **Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Olschwang**

(provisional application No. 60/452526) in view of **Cohen et al (US Patent No.: 6,385,308 B1).**

        Consider **claim 1 and 5** Olschwang clearly shows and discloses the Fun-Dial customized ring

back tone solution (a tone information providing system) comprising when A (calling-terminal) calls B

(called-terminal), SSP (receiving means) receives a call (calling information) from A (calling-terminal);

SSP sends an IN message to the Fun-dial SCP, based on the called party B number; The SCP indicates

that A and B numbers (tone information including called-terminal specifying information for specifying

the communication terminal and called-terminal specifying information for specifying a communication

terminal for a calling destination); The Content Delivery Platform VoiCD at this point will identify the

subscriber B and the caller A (tone information selecting means) that has been stored (tone information

storing means) then the Content Delivery Platform will transmit (transmitting means) the content tone to

A. (Page 2 line 6- 12 and page 10 line 1-8, figure "Network Topology" in page 3, figure "flow details" in

page 4, figure "Ring back Tone Basic Call Flow scenario" in page 10); The VoiCD system database has

the following (tone information recording means, tone information storing means, and past-record

selecting means); it is used for storing subscriber related information, content storing and content related

information (relating the calling-terminal specifying information, the called-terminal specifying

information and the tone information) (Page 32 section 4.2.5 line 1-2 and section 4.2.6 line 12);

Olschwang clearly shows that the user can receive information regarding the tone information; VoiCD

Call Data Records CDRs (past-record information storing means) are generated for each successful call

for both caller A or subscriber B for transmission ring tones information after receiving the request

process (request receiving means) (Page 32, section 4.2.6 lines 20- 23 and page 36 section 6.1.2, line 8-

15); however, **Olschwang** does not specifically disclose time information indicating time when user

talked through the communication terminal.

In the same field of endeavor, **Cohen** clearly discloses that time information indicating time when

user talked through the communication terminal; the record means stored in the processor for each

designated calling party define the parameters (such as called-terminal specifying information for

specifying the communication terminal and called-terminal specifying information for specifying a

communication terminal for a calling destination, and time information) for each personalized

announcement (abstract; col. 7, lines 25-28; and col. 8, lines 15-30).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the

invention was made to add the time information indicating time when user talked through the

communication terminal to the tone information and then store these pieces of information in the record

means (past-record information storing means) as taught by Cohen in Olschwang, in order to determine

when the user talked through the communication terminal and store time information with relate pieces of

information (abstract, col. 8, lines 15-20).

   Consider **Claims 3 and 6, Olschwang and Cohen** clearly shows the tone information providing

system according to claim 1, wherein time information relating to the time when the transmitting means

has transmitted the tone information is related to the calling-terminal specifying information, the called-

terminal specifying information and the tone information, and these pieces of information are stored in the

past-record information storing means (Cohen: col. 8, lines 15-30; and claim 11)

   Consider **Claims 4 and 7, Olschwang and Cohen** clearly show The tone information providing

system according to claim 1, wherein the disclosure request includes time information relating to the time

when the transmitting means has transmitted the tone information (Cohen: col. 8, lines 15-30; abstract;

and Olschwang: paragraph 4.2.4).

Response to Arguments

3.   The present Office Action is in response to Applicant's amendment filed on October 16, 2008.

Applicant has amended **claims 1 and 5**; claims **1 – 7** are now pending in the present application.

4.   The Examiner's rejection under 35 USC § 112 second paragraph is withdrawn since the claim has

been amended as suggested by the Examiner.

5.   Applicant's arguments with respect to amended claims 1 and 5 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the

extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amal Zenati whose telephone number is **571-270-1947.** The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571- 272- 7499. The fax phone number for the organization where this application or proceeding is assigned is 571- 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/CURTIS KUNTZ/   /Amal Zenati/
Supervisory Patent Examiner, Art Unit 2614   Patent Examiner, Art Unit 2614

January 30, 2009